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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/736,404

12/15/2003

William Sobonya

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27885

7590

01/25/2007

FAY SHARPE LLP

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EXAMINER

RUDDOCK, ULA CORINNA

ART UNIT

PAPER NUMBER

1771

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/736,404

Applicant(s)

SOBONYA, WILLIAM

Examiner

Ula C. Ruddock

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner has carefully considered Applicant's response filed November 1, 2006. The rejections have been maintained. The 112, 2nd paragraph rejection has been overcome by the present amendment.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

3. The declaration under 37 CFR 1.132 filed May 3, 2006, is insufficient to overcome the rejection of claims 1-17 as set forth in the last Office action because:

There is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04. ***Applicant argues that their showing is sufficient because at least some of the cited references on the IDS were working on the problems recited in the present application. However, it is still unclear if the inventors cited on the IDS had been aware of the references that have been cited in this rejection would have or would not have been able to address the problems.***

Furthermore, gross sales do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F. 2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988). See MPEP § 716.03. ***Furthermore, Applicant has not accounted for the buyers of the***

product, the pricing, and whether a pre-existing relationship with the buyers had been established.

Claim Rejections - 35 USC § 103

4. Claims 1, 2, 3, 10, 11, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fagan (US 4,783,354) in view of GB 1541311 (GB '311). Fagan disclose a sheet material suitable for use as shelving paper (abstract). The sheet material adheres firmly to a surface, yet can be readily removed therefrom or repositioned without marring or damaging the surface. Additionally, the adherable, yet releasable and removable nature of the sheet material is maintained over time (col 3, ln 21-30). The invention can include a laminate comprising a top sheet of vinyl film laminated with adhesive to a polyester, non-woven backing, wherein the front side of the base sheet may be embossed (col 7, ln 18-26). Fagan discloses that the vinyl film can have a thickness of 4 mils (col 9, ln 4). Fagan discloses the claimed invention except for the teaching that a clear polypropylene protective layer is adhered to the vinyl film.

GB '311 discloses laminates for covering substrates for decorative and/or protective purposes such as shelving covers (pg 1, ln 14-15 and 30-31). The laminate is easily positioned and adhered to the substrate, and which can be removed and repositioned (pg 2, ln 19-23). A facing layer is included in the laminate and can generally be a sheet material which can be decorative or protective. Materials for the facing layer include polypropylene. The facing layer may have a decorate pattern embossed thereon (pg 4, ln 45-62). The polypropylene top layer can be substantially transparent and can be used to protect a lower sheet made of polyvinyl chloride (pg 4, ln 63-74). It would have been obvious to one having ordinary skill in the art to use the transparent

and embossed polypropylene protective sheet of GB '311 on the laminate of Fagan, motivated by the desire to create a laminate that has the desired aesthetics and the protective feature provided by the polypropylene sheet.

Regarding claim 3, it should be noted that optimizing the thickness of the vinyl film is a result effective variable. The thickness of the film directly affects the durability of the entire laminate. Therefore, it would have been obvious to one having ordinary skill in the art to have made the thickness of the vinyl film be 8 mils, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have optimized the film thickness motivated by the desire to create a laminate having increased durability.

Rejection is maintained.

5. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fagan (US 4,783,354) and GB 1541311 (GB '311) as applied to claim 1 above, and further in view of Owen (US 5,874,371). Fagan and GB '311 disclose that the backing may be a polyester nonwoven, but fails to disclose the teaching that the backing is a woven or non-woven plastic scrim and that the backing is coated with a polyvinyl chloride resin.

Owen (US 5,874,371) discloses a non-skid covering for use on a surface (abstract). The scrim comprises a PVC coated non-woven scrim (claims 2, 3, 5, and 6). It would have been obvious to have used Owen's PVC coated woven or non-woven plastic scrim as the backing material in the laminate of Fagan and GB '311, motivated by the desire to create a laminate that is lightweight and has strength, durability, and non-slip properties.

Rejection is maintained.

6. Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fagan (US 4,783,354) in view of GB 1541311 (GB '311) and Schottenfeld (US 2002/0094404). Fagan disclose a sheet material suitable for use as shelving paper (abstract). The sheet material adheres firmly to a surface, yet can be readily removed therefrom or repositioned without marring or damaging the surface. Additionally, the adherable, yet releasable and removable nature of the sheet material is maintained over time (col 3, ln 21-30). The invention can include a laminate comprising a top sheet of vinyl film laminated with adhesive to a polyester, non-woven backing, wherein the front side of the base sheet may be embossed (col 7, ln 18-26). Fagan discloses the claimed invention except for the teaching that a clear polypropylene protective layer is adhered to the vinyl film and that there is a protective removable covering on the laminate.

GB '311 discloses laminates for covering substrates for decorative and/or protective purposes such as shelving covers (pg 1, ln 14-15 and 30-31). The laminate is easily positioned and adhered to the substrate, and which can be removed and repositioned (pg 2, ln 19-23). A facing layer is included in the laminate and can generally be a sheet material which can be decorative or protective. Materials for the facing layer include polypropylene. The facing layer may have a decorate pattern embossed thereon (pg 4, ln 45-62). The polypropylene top layer can be substantially transparent and can be used to protect a lower sheet made of polyvinyl chloride (pg 4, ln 63-74). It would have been obvious to one having ordinary skill in the art to use the transparent and embossed polypropylene protective sheet of GB '311 on the laminate of Fagan, motivated by

the desire to create a laminate that has the desired aesthetics and the protective feature provided by the polypropylene sheet.

Schottenfeld (US 2002/0094404) discloses a liner for covering a generally smooth surface comprising a PVC sheet [0019] and a PVC coated scrim [0020]. A release layer is added to the liner [0024]. It would have been obvious to one having ordinary skill in the art to have used the release layer of Schottenfeld in the laminate of Fagan and GB '311, motivated by the desire to create a laminate that has ease of shipping and improved handling characteristics.

Regarding claim 14, it should be noted that optimizing the thickness of the vinyl film is a result effective variable. The thickness of the film directly affects the durability of the entire laminate. Therefore, it would have been obvious to one having ordinary skill in the art to have made the thickness of the vinyl film be 8 mils, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have optimized the film thickness motivated by the desire to create a laminate having increased durability.

Rejection is maintained.

Response to Arguments

7. Applicant's arguments filed November 1, 2006, have been fully considered but they are not persuasive for the reasons set forth. Applicant argues that neither Fagan nor GB '311 disclose a non-adhesive sheet material. This argument is not persuasive because Fagan specifically discloses that their sheet material adheres firmly to a surface, yet can be readily removed therefrom or repositioned without marring or damaging the surface. Additionally, the adherable, yet

releasable and removable nature of the sheet material is maintained over time (col 3, ln 21-30). Therefore, it is the Examiner's position that Fagan discloses a "non-adhesive sheet material" as defined by Applicant. Furthermore, it should be noted that the present claims are written in open language and as a result, do not preclude the use of additional components. Applicant also argues that the rejection of claims 12-16 is improper and based on hindsight. This argument is not persuasive because the references used to reject claims 12-16 are properly combinable as they are all drawn to shelf liners. Therefore, the references are analogous and one having ordinary skill in the art would have found it obvious to have modified Fagan's shelf liner with the polypropylene top layer of GB '311 and the release layer of Schottenfeld. As a result, the rejections are maintained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

UCR 


Ula C. Ruddock
Primary Examiner
EBC Center 1700